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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,657	11/29/2001	Charles Raymond Degenhardt	8375D	6277

27752 7590 03/11/2002

THE PROCTER & GAMBLE COMPANY  
PATENT DIVISION  
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EXAMINER

DESAI, RITA J

ART UNIT PAPER NUMBER

1625

DATE MAILED: 03/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/996,657

Applicant(s)

DEGENHARDT ET AL.

Examiner

RITA J. DESAI

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-16 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other:  |

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 3,4,6,7,8 and 1,2,5,11-16 in part, drawn to compounds, pharmaceutical compositions and methods of treating wherein D4 is a CO, R2 is as given in claim 6, R1 is a Hydrogen or a hydroxyl, x is 0 or 1, A4 is a six membered with one nitrogen, D5 is OR6, R6 is a heteroaromatic ring classified in class 546, 514 subclass 225, 226 and 318, 320, 330. A further election of a single disclosed species for search purposes is required.
- II. Claims 10 and 1,2, 5,11-16 in part, drawn to compounds, pharmaceutical compositions and methods of treating wherein D4 is CHR1, D5 is -NHR6, R2 is as given in claim 6, R1 is a Hydrogen or a hydroxyl, x is 0 or 1, A4 is a six membered with one nitrogen, R6 is a heteroaromatic ring classified in class 546, 514 subclass 207, 208, and 318, 331. A further election of a single disclosed species is required for search purposes.
- III. Claim 9 and 1,2, 5,11-16 in part, drawn to compounds, pharmaceutical compositions and methods of treating wherein D4 is CHR1, D5 is -OR6, R2 is as given in claim 6, R1 is a Hydrogen or a hydroxyl, x is 0 or 1, A4 is a six membered with one nitrogen, R6 is a heteroaromatic ring, classified in class 546, 514, subclass 236, 326. A further election of a single disclosed species for search purposes is required.

Art Unit: 1625

IV. Claims 1,2,5,11-16 in part , drawn to groups not included in the above groups.

This group is subject to further restriction. A further election of a single disclosed species for search purposes is required.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are independent and distinct since they do not have a common core. There is no common core.

Ring A4 can be a ring of 4 to 9 atoms and every other group A1-A3 and R1, R2, D1, D2, R6 all are variables and the permutations and combinations gives rise to numerous compounds.

The bonding and hence the properties are no longer the same. If applicants argue that they have the same utility then by the same reasoning would all analgesics be considered as one invention.

If applicant 's traverse on the grounds that the inventions are not patentably distinct, applicants should submit evidence or identify such evidence now of record showing the groups to be obvious variants or clearly admit on the record that this is the case. In either instance if the examiner finds one of the inventions unpatentable over the prior art , the evidence or admission may be used in a rejection under 35 USC 103 of the other invention.

A preliminary search on just a limited core also gave an incomplete search.

Art Unit: 1625

=> s 11

SAMPLE SEARCH INITIATED 11:58:46 FILE 'REGISTRY'

SAMPLE SCREEN SEARCH COMPLETED - 19923 TO ITERATE

5.0% PROCESSED 1000 ITERATIONS 0 ANSWERS

INCOMPLETE SEARCH (SYSTEM LIMIT EXCEEDED)

SEARCH TIME: 00.00.01

FULL FILE PROJECTIONS: ONLINE \*\*INCOMPLETE\*\*

BATCH \*\*COMPLETE\*\*

PROJECTED ITERATIONS: 390037 TO 406883

PROJECTED ANSWERS: 0 TO 0

L2 0 SEA SSS SAM L1

=> s 13

SAMPLE SEARCH INITIATED 12:08:04 FILE 'REGISTRY'

SAMPLE SCREEN SEARCH COMPLETED - 54166 TO ITERATE

1.8% PROCESSED 1000 ITERATIONS 0 ANSWERS

INCOMPLETE SEARCH (SYSTEM LIMIT EXCEEDED)

SEARCH TIME: 00.00.02

FULL FILE PROJECTIONS: ONLINE \*\*INCOMPLETE\*\*

BATCH \*\*INCOMPLETE\*\*

PROJECTED ITERATIONS: EXCEEDS 1000000

PROJECTED ANSWERS: EXCEEDS 0

This indicates that the core is not novel and does not constitute a distinct portion over the prior art and hence the groups are patentably independent and distinct.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Art Unit: 1625

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

A attempt was made to call Catherine Brown on 3/4/2002 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicants are required to cancel the non-elected subject matter if the restriction is not traversed. Applicants preserve their right to file a divisional on the cancelled non-elected subject matter, without prejudice, in due course.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RITA J. DESAI whose telephone number is 703-305-1868. The examiner can normally be reached on Monday - Friday, 9:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on 703-308-4698. The fax phone numbers for the

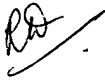
Application/Control Number: 09/996,657

Page 6

Art Unit: 1625

organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-7922 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

  
R.D.  
March 8, 2002